



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,303	12/02/2003	Paul Gallagher	12729-102	5215

56020 7590 07/12/2006

BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
----------	--------------

3693

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/727,303		GALLAGHER ET AL.	
	Examiner		Art Unit	
	Jason M. Borlinghaus		3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8,11, 23-25,28-29,36-42,48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,11, 23-25,28-29,36-42,48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/24/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

To ensure clarity and clear understanding of examiner's rationale for application of cited prior art, terminology contained within parentheses indicates quoted language contained within said cited prior art reference while unquoted language contained within parentheses indicates the general concept as conveyed by said cited prior art reference. Such parenthetical terminology is to be interpreted as "reading on" or being "mapped to" the claim language prior to such parenthetical inclusions.

Claims 1 - 2, 6 - 8, 11, 23 - 24, 28 - 29, 36-39, 41-42 and 48 are rejected under 35 U.S.C. 103(a) as being anticipated by Barbara (PG Pub 2002/0016769).

Regarding Claims 1 - 2, 5, and 8, Barbara discloses a computer implemented method transferring funds from an online account associated with a first user ("customer transaction account") to a recipient online account ("recipient transaction account") (see fig.1), the method comprising:

- receiving a transfer request from the first user ("customer"), the transfer request including an amount of funds for transfer from the online account ("customer transaction account") and identification information for a recipient of the funds, the identification information including an electronic message address associated with the recipient. (see p. 4, para. 52 - 54 and fig. 3);
- automatically sending an electronic message to the recipient using the electronic message address, the electronic message indicating that funds are ready for transfer to the recipient. (see p. 4, para. 55 and fig. 4);
- receiving a response wherein upon accepting the transfer of funds, the response includes a request by the recipient to open an account ("elects to register"). (see p. 4, para. 55 – 56 and fig. 4);
- opening/identifying the recipient online account for the recipient ("recipient account"). (see p. 4, para. 55);
- transferring said amount of funds from the first account ("customer transaction account") to the recipient online account associated with the recipient ("recipient transaction account"). (see p. 3, para. 50);

- wherein the response ("elect[ion] to register") includes information identifying the recipient online account. ("designate which account he or she wants to use as the recipient account"). (see p. 4, para. 55);
- wherein the electronic message address comprises an e-mail address, and wherein the electronic message is an e-mail message. (see p. 4, para. 54 – 55 and fig. 3 - 4); and
- further including the step of opening ("register[ing] for the service") the first account ("customer transaction account") in response to a request from the first user to open the first account . (see p. 3, para. 50; fig. 1 and 3).

Barbara does not teach underlined limitations - a method comprising the steps of:

- receiving a response from the recipient accepting or rejecting the transfer of funds wherein upon accepting the transfer of funds the response includes a request by the recipient to open an account; and
- transferring said amount of funds from the first account to the recipient online account associated with the recipient if the response indicates acceptance, wherein if the response indicates acceptance, the response includes information identifying the recipient online account.

Acceptance and rejection of funds by the intended recipient and communication of such acceptance or rejection is old and well known in the art of banking and financial transactions, especially in regards to acceptance and rejection of cash and checks in conventional manual person-to-person transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara

to incorporate the ability for the recipient to accept or refuse the transfer of funds, as is old and well known, allowing for the incorporation and automation of a well established step in fund transfer activities into the present automated fund transfer system.

Regarding Claims 6-7, Barbara discloses a method comprising the steps of:

- receiving a transfer request from the first user ("customer"), the transfer request including an amount of funds for transfer from the first online account ("customer transaction account") and identification information ("e-mail address") for a recipient of the funds, the identification information including an electronic message address for the recipient. (see p. 4, para. 54; fig. 1 and 3);
- automatically sending an electronic message to the recipient using the electronic message address, the electronic message indicating that funds are ready for transfer to the recipient. (see p. 4, para. 55 and fig. 4); and
- transferring said amount of funds from the first account ("customer transaction account") to the recipient account ("recipient transaction account"). (see p. 3, para. 50 and fig. 1).

Barbara does not teach underlined limitations - a method comprising the steps of:

- wherein the transfer request further includes a request for identity confirmation using a query;
- receiving a response from the recipient accepting or rejecting the transfer of funds wherein the response from the recipient includes identity

information and an answer to the query responsive to the request for identity confirmation;

- automatically sending the identity information to the first user;
- receiving from the first user an acceptance or a rejection of the identity information;
- transferring said amount of funds from the first account to the recipient account if the response from the recipient indicates acceptance and if the acceptance of the identity information is received from the first user; and
- wherein the request for identity confirmation includes the query, and wherein the information from the recipient includes the answer to the query.

Acceptance and rejection of funds by the intended recipient and communication of such acceptance or rejection is old and well known in the art of banking and financial transactions, especially in regards to acceptance and rejection of cash and checks in conventional manual person-to-person transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate the ability for the recipient to accept or refuse the transfer of funds, as is old and well known, allowing for the incorporation and automation of a well established step in fund transfer activities into the present automated fund transfer system.

Requesting identity confirmation from the intended recipient of funds, retrieving information to satisfy such request and making the disbursement of funds conditional upon satisfaction is old and well known in the art of banking and financial transactions,

especially in regards to checking identity of recipients when cashing check, or when paying with a check and credit card, such as in conventional manual person-to-person transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate the ability to request identity confirmation of the recipient, to accept such information from the recipient and transfer funds based upon the satisfaction of the identity confirmation, as is old and well known, allowing for the incorporation and automation of a well established step in fund transfer activities into the present automated fund transfer system.

Regarding Claim 11, Barbara discloses a method:

- wherein the method is implemented in a host server (“computer of service provider”). (see p. 3, para. 49 and fig. 1);
- wherein the method is implemented through a URL (“enrollment page”). (see s1, fig. 2); and
- sending an electronic message. (see p. 4, para. 55 and fig. 4).

Barbara does not teach a method

- wherein the method is implemented in a host server, and wherein the electronic message includes a URL link to the host server.

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to have modified Barbara to incorporate a URL link to the host server in the electronic message to allow for the recipient of the electronic message to easily and simply connect to and register with the system.

Regarding Claims 23-24, further system claims would have been obvious from method claims rejected above, Claims 1 - 2, and are therefore rejected using the same art and rationale.

Regarding Claims 28 –29, further system claims would have been obvious from methods claims rejected above, Claims 6 - 7, and is therefore rejected using the same art and rationale.

Regarding Claim 36, a method comprising the steps of:

- receiving a transfer request to transfer funds from a first online account associated with a first user (“customer transaction account”) to a second online account (“recipient transaction account”) associated with a second user (“recipient”), wherein the transfer request includes a bank identifier (account designation, such as “deposit account number and/or an American Bankers Association (ABA) number of the financial institution with which the deposit account is maintained”) that identifies a first of the plurality of the affiliate banks (“deposit account, such as a checking account, and/or a money market account of the user, is designated as the source account”). (see p. 2, para. 17; p. 4, para. 54; fig. 1 and 3);
- transferring funds from the first online account (“customer transaction account”) to the second online account (“recipient transaction account”). (“Thus, the customer that registers for the service is able to have funds reside in the transaction account and to transmit funds from that account

to other users, such as recipient, once the recipient is also enrolled.” – see p. 3, para. 50); and

- wherein the identified first affiliate bank (“system provider can be a financial institution”) conducts the fund transfer settlement for the transferred funds on behalf of the first user (“customer”). (see p. 5, para. 60).

Barbara does not teach underlined limitations - a method comprising the steps of:

- transferring funds from the first online account to the second online account after the second user has approved the transfer request

Acceptance and rejection of funds by the intended recipient and communication of such acceptance or rejection is old and well known in the art of banking and financial transactions, especially in regards to acceptance and rejection of cash and checks in conventional manual person-to-person transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate the ability for the recipient to accept or refuse the transfer of funds, as is old and well known, allowing for the incorporation and automation of a well established step in fund transfer activities into the present automated fund transfer system.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to incorporate to condition the transfer of funds upon the acceptance or rejection of such fund transfer by the intended recipient, as is old and well known, allowing the recipient to enforce their decision concerning their acceptance or rejection of the offered funds.

Regarding Claim 37, Barbara discloses a method wherein:

- the settlement includes one of an ACH transaction, a check card transaction and a credit card transaction. (see pp. 3 - 4, para. 50 and p. 7, para. 73).

Regarding Claim 38, Claim 38 recites similar limitations to a portion of Claim 1 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1.

Regarding Claim 39, Claim 39 recites similar limitations to a portion of Claim 2 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1.

Regarding Claim 41, Barbara discloses a method further including:

- the step of receiving a second bank identifier ("checking account") from the second user, the second bank identifier identifying one of the affiliate banks ("financial institution") for conducting fund transfer settlement on behalf of the second user. (see p. 4, para. 56 and p. 5, para. 60).

Regarding Claim 42, Barbara discloses a method wherein:

- the first and second bank identifiers indicate the same affiliate bank. (see p. 5, para. 60).

Regarding Claim 48, Barbara discloses a method wherein:

- the transfer request includes a request from the first user ("customer") to pay funds to the second user (recipient). (see p. 4, para. 0054 and fig. 3).

Claims 3, 25 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barbara, as with Claims 1, 23 and 38 above, in view of Saylor (PG Pub 2004/0111370).

Regarding Claims 3 and 40, Barbara does not teach underlined limitation - a method wherein:

- the electronic message address includes a user ID associated with the recipient, and wherein the step of automatically sending an electronic message includes initiating an instant message session with the recipient based on the user ID.

Saylor discloses a method wherein:

- the electronic message address includes a user ID associated with the recipient, and wherein the step of automatically sending an electronic message includes initiating an instant message session with the recipient based on the user ID. ("For example, "email" may be replaced with a voice mail or instant messaging." – see p. 18, para. 168 – establishing that instant messaging notification of recipient could be used in place of email notification of recipient. It would, therefore, be inherent in utilizing instant messaging communication that the system request the recipient's user ID in substitution for or in addition to the recipient's email address for instant messaging communication to take place).

It would have been obvious to one of ordinary skill in the art at the time that the invention as made to have modified Barbara to incorporate instant messaging, as was

done by Saylor, to allow the system to communicate to the recipient through a variety of electronic means.

Regarding Claim 25, further system claim would have been obvious from method claim rejected above and is therefore rejected using the same art and rationale.

Response to Arguments

Applicant's arguments filed 4/24/06 have been fully considered but they are not persuasive.

In response to applicant's argument concerning the §103 rejection of Claims 1, 23 and 28, specifically applicant's argument that Barbara does not disclose "receiving a response from the recipient accepting or rejecting the transfer of funds wherein the response includes a request by the recipient to open an account," examiner asserts that while Barbara does not teach such claim limitation, such claim limitation is obvious based upon Barbara, and old and well-known knowledge in the art.

Barbara discloses a system receiving a response from the recipient accepting the transfer of funds wherein the response includes a request by the recipient to open an account. In Barbara, the system receives a response from the recipient in response to a prompt from the system to register to the service (see p.4, para. 55 and s18, fig. 4), thereby allowing for acceptance of transmitted funds, and wherein the response includes a request by the recipient to open an account with the EFT service (see p. 4, para. 55 and s18, fig. 4). Furthermore, as the recipient accepts the transferred funds via registration with the EFT service, the system transfers funds from first account

("customer transaction account") to the recipient online account ("recipient account"), associated by the recipient and identified by the recipient. (see p. 4, para. 55 and fig. 1). While Barbara does not teach the explicit acceptance or refusal of transferred funds, inaction on the part of the recipient would be an implicit refusal of the transferred funds, as the funds would remain unclaimed.

Examiner would also like to point out that Official Notice was used in the office actions mailed on 12/22/05 to indicate that it is old and well known in the art that acceptance and rejection of funds by the intended recipient and communication of such acceptance or rejection. Otherwise, potential recipients would be unable to refuse acceptance of offered funds, possibly finding themselves ensnared and entangled in undesired financial interaction with other parties. Since applicant has not attempted to traverse this Official Notice statement, examiner is taking the common knowledge or well-known statement to be admitted prior art.

Taken together, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara by incorporating the active acceptance or rejection of the transferred funds, as is old and well-known, to prevent recipients from being forced into undesired and/or unwanted financial interaction with other parties.

In response to applicant's argument concerning the §103 rejection of Claim 1, 6, 23 and 29, specifically applicant's argument that Barbara does not disclose "the use of a query and the answer to the query for identity confirmation," examiner asserts

that while Barbara does not teach such claim limitation, such claim limitation is obvious based upon Barbara, and old and well-known knowledge in the art.

Applicant argues that "Barbara does not discuss identity confirmation...The system utilizes e-mail addresses for identity and therefore does not contemplate the need for additional identity confirmation." However, Barbara does discuss additional identity confirmation protocols in addition to the use of email addresses such as utilization of a "verification and validation process" in regards to the recipient designated account "in order to minimize fraud." (see p. 4, para. 55 – 56).

Examiner would also like to point out that Official Notice was used in the office actions mailed on 12/22/05 to indicate that it is old and well known in the art that requesting identity confirmation from the intended recipient of funds, retrieving information to satisfy such request and making the disbursement of funds conditional upon satisfaction. Such authentication procedures were already utilized at the time the invention was made in traditional banking and financial transactions, such as checking identity of recipients when cashing a check in conventional manual person-to-person or posing queries (ie. mother's maiden name, social security number or favorite pet's name) for identity confirmation in financial transactions. Since applicant has not attempted to traverse this Official Notice statement, examiner is taking the common knowledge or well-known statement to be admitted prior art.

Taken together, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara by incorporating the ability to request identity confirmation of the recipient, to accept such information from the

recipient and transfer funds based upon the satisfaction of the identity confirmation, as is old and well known, providing an additional level of identity confirmation and/or security to the proposed financial system.

In response to applicant's argument concerning the §103 rejection of Claim 36, specifically applicant's argument that Barbara does not disclose "the transfer identifies a plurality of affiliate banks," examiner asserts that Barbara does teach such claim limitation.

Barbara discloses a system that is operated by a service provider (see p. 3, para. 48). "The system provider can be a financial institution, such as a bank, and the funding sources, can be banking accounts with the service providing bank or with other financial institutions or banks. It is not necessary for a customer, such as customer or recipient, that uses the system to have banking accounts with the service providing bank." (see p. 5, para. 60). Furthermore, system users identify their respective banking accounts through identifiers "such as a deposit account number and/or an American Bankers Association (ABA) number of a financial institution." (see p. 2, para. 17).

Upon the basis of Barbara's disclosure the three elements of the system – (1) the system provider, (2) the source of funds and (3) the destination of funds - can be located within the same bank or each element may be located at different banks. Having the transfer process performed by one of "a plurality of affiliate banks" is merely a matter of design choice, as it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Barbara to allow for any configuration of banks that the inventor desired, such as the entire transfer occurring in

the same banking system or among multiple banks, as disclosed by Barbara. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

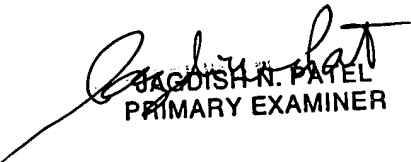
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone

Art Unit: 3693

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JAGDISH N. PATEL
PRIMARY EXAMINER